

Appl. No.: 10/619,535
Reply to Office Action of Mar. 24, 2005

Remarks In Response to the Office Action

A. General Remarks

Claims 1-51 are pending in the application. No claims have been added, cancelled, or amended in this Reply.

For the convenience of the Examiner, Applicant has reprinted portions of the Office Action mailed 3/24/05 in bolded and italicized type. Applicant's statements or arguments immediately follow each section.

B. Allowable Subject Matter

6. *Claims 1-51 would be allowable if the Specification, the Drawings and the claims are rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office Action.*

Applicant appreciates the indication of allowability by the Examiner. As argued below, Applicant believes the objection to the drawings and the rejection to the claims are improper. Accordingly, Applicant believes that claims 1-51 are in condition for allowance and respectfully requests a Notice of Allowance as the next paper from the Office.

C. Drawing Objections

3. *The drawings are objected to because the specific structure of the mechanism, which allows rotation in two orthogonal planes, is not clearly shown. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. No new matter should be entered. The objection to the drawings will not be held in abeyance.*

Applicant respectfully traverses the objection to the drawings. The Office Action fails to cite any requirement in Title 35 of the United States Code or Title 37 of the Code of Federal Regulations under which Applicant is required to make the proposed corrections to the drawings. Nevertheless, Applicant points out that Applicant has complied with 35 U.S.C. § 113 and 37 C.F.R. § 1.81 by furnishing a drawing where necessary for the understanding of the subject matter to be patented. Therefore, the objection to the drawings is believed to be improper, and Applicant respectfully requests withdrawal of the objection to the drawings.

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D. Claim Rejections - 35 USC § 112

5. Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant's claims are deemed unclear because the specific structure of the mechanism, which allows rotation in two orthogonal planes, is not clearly described in the Specification nor shown in the Drawings. Appropriate correction is required. No new matter should be entered.

Applicant respectfully traverses the rejection to claims 1-51. As the Examiner is aware, such a rejection for lack of enablement should be used when it is the Examiner's position that nothing within the scope of the claims is enabled. See MPEP 706.03(c). Applicant disagrees with such a contention.

It is the Examiner's burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). For the burden, the Office Action merely states that the "claims are deemed unclear because the specific structure of the mechanism, which allows rotation in two orthogonal planes, is not clearly described in the Specification nor shown in the Drawings." Under the law, this statement constitutes an insufficient basis to question the enablement provided by Applicant's specification and drawings. In particular, MPEP 2164.01(a) provides factors for determining enablement:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and

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(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.
In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Moreover, the determination of lack of enablement "is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations" MPEP 2164.01(a) citing *In Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Because the Office Action gives a single, simple determination as its basis for questioning the enablement of Applicant's specification, Applicant believes the rejection to claims 1-51 under 35 U.S.C. § 112, first paragraph, is not well-founded and is improper. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Nevertheless, Applicant stresses that Applicant's claims contain subject matter that is described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See 35 U.S.C. § 112. By way of example, Figures 2A-2B show and Paragraph [0020] describe a connector 200 that has two connection mechanisms 215 and 220. The "[m]echanism 215 allows connector head 210 to rotate in the Y-Z plane, while mechanism 220 allows connector head 210 to rotate in the X-Z plane. As illustrated in FIG. 2A, rotational mechanism 215 has an approximately $\pm 90^\circ$ range of motion relative to the long axis of connector head 205. As illustrated in FIG. 2B, rotational mechanism 220 allows rotation of connector 210 in the X-Z plane of up to approximately 120° (clockwise or counterclockwise)." *Present Specification* at Paragraph [0020].

In addition, Figures 2A-2B show and Paragraph [0021] describe that:

[O]ne or both of mechanisms 215 and 220 provide a fixedly adjustable positioning mechanism. That is, either or both of mechanisms 215 and 220 may be designed to retain a user-specified position and to hold that position until affirmatively altered. In these embodiments, an applied external force is required to place mechanisms 215 and 220 in a first position, wherein the weight of the connector heads and/or stand-alone device would not generally be sufficient to rotate either mechanism 215 or 220. One of ordinary skill in the art will recognize there are many means to implement this feature. For example, a hinge for

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rotation and friction for holding a connector in place is one means. Another means may use two mating planar surfaces to keep the rotation motion along a predetermined track or path and also increase the surface area for more stationary friction when a desirable position is reached. A third means could use a ball and socket universal joint similar in function to those used in conventional shower-heads.

Given the above examples, one person skilled in the art will see that these portions of the specification show and describe rotational mechanisms (*e.g.*, hinges) being rotatable about axes and show and describe friction surfaces and mating surfaces to retain the rotational mechanisms in a user-specified position and to hold that position until affirmatively altered. Consequently, these and other portions of the Figures and written description of Applicant's specification comply with 35 U.S.C. § 112, and the claims contain subject matter which was described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

If the rejection of claims 1-51 for lack of enablement is based on the Examiner's personal knowledge, Applicant would like to point out the duty spelled out in 37 C.F.R. § 1.104(d)(2). In particular, Applicant requests that specific details be provided for the rejection and that the details be supported by an affidavit from the Examiner in compliance with 37 C.F.R. § 1.104(d)(2).

* * * * *

No fees are believed due. However, the undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application. In addition, should any fees be due for any reason, the undersigned representative authorizes the Commissioner to charge any additional fees that may be required to Wong Cabello's Deposit Account No. 501922, referencing order no. 175-0002US.

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To facilitate the resolution of any issues or questions presented by this paper, Applicants respectfully request that the Examiner directly contact the undersigned by phone to further the discussion, reconsideration, and allowance of the claims.

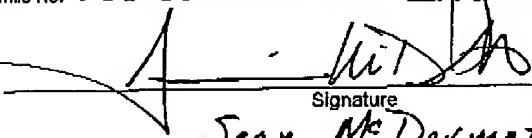
Respectfully submitted,

Date:

May 16, 2005

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